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In re Application of:	:	
BURTON, David, et al.	:	DECISION ON REQUEST UNDER
U.S. Application No.: 10/594,181	:	37 CFR 1.497(d)
PCT No.: PCT/US2005/010037	:	
International Filing Date: 24 March 2005	:	
Priority Date: 26 March 2004	:	
Docket No.: 8627-1397 (PA-5496-PCT/US)	:	
For: METHOD AND APPARATUS FOR	:	
AN IMPROVED LUER FITTING	:	
CONNECTION	:	

This decision is issued in response to the "Petition Pursuant To MPEP 1.497(d)(1)" filed 23 July 2007, treated herein as a request under 37 CFR 1.497(d) to correct the inventorship for the present application. Applicants have submitted the required processing fee.

**BACKGROUND**

On 24 March 2005, applicants filed international application PCT/US2005/010037. The international application claimed a priority date of 26 March 2004, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 26 September 2006.

The published international application identified two corporate applicants for all states other than the U.S., and two applicant/inventors with respect to the U.S.: David BURTON and Scott PHILHOWER.

On 25 September 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 23 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration acceptable under 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 23 July 2007, applicants filed a response to the Notification Of Missing Requirements (with one-month extension fee) that included the required surcharge payment, a declaration document executed by the two inventors listed on the international application as well as a third

inventor, Nicholas J. ELY, and the request under 37 CFR 1.497(d) considered herein. The request under 37 CFR 1.497(d) seeks to add Nicolas J. ELY as an inventor of record.

### DISCUSSION

Section 1893.01(e) of the MPEP states the following regarding changes in the inventorship of an international application entering the national stage (emphasis added):

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. See 37 CFR 1.41(a)(4). Accordingly, **an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied.** These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

As noted above, applicants have filed a declaration document that includes a third inventor who was not identified as an inventor in the international application. Accordingly, applicants must satisfy the requirements of 37 CFR 1.497(d) before such declaration can be accepted.

With respect to requirement (A) above, applicants have not provided a statement from the person being added as an inventor (Nicolas J. ELY) stating that any error in inventorship in the international application occurred without deceptive intention on his part. Requirement (A) is therefore not satisfied.

With respect to requirement (B) above, applicants have submitted the required processing fee. Requirement (B) is therefore satisfied.

With respect to item (C) above, applicants have not submitted the written consent of the assignee to the change of inventorship. No assignment has been recorded herein; however, the 23 July 2007 submission includes two "Power Of Attorney By Assignee And Correspondence Address Indication" forms executed on behalf of two different corporations (Cook Incorporated and Sabin Corporation), each of which assert that they are the assignee of the present application. Neither of these purported assignees has submitted their consent to the addition of the third inventor. Moreover, neither of the assignees has submitted an acceptable 3.73(b) statement, as would be required before any such consent can be accepted (specifically, the present submission does not indicate the reel and frame number of any recorded assignments, nor is it accompanied

by a copy of any relevant assignments). Before item (C) can be considered satisfied, applicant must submit the written consent of the assignee(s) to the change in inventorship. Any such consent of the assignee(s) must be accompanied by a proper statement under 37 CFR 3.73(b).

Based on the above, applicants have failed to submit all the requirements of a grantable request to correct the inventive entity pursuant to 37 CFR 1.497(d).

In addition, it is noted that the declaration filed 23 July 2007 is not in an acceptable form. Specifically, the declaration appears to be a compilation of multiple separately executed declarations, and as such is not acceptable under 37 CFR 1.497.<sup>1</sup> See MPEP § 201.03(II)(B): “Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.” Thus, even if the third inventor was made of record herein, applicants have failed to provide an acceptable oath or declaration in compliance with 37 CFR 1.497.

### CONCLUSION

Applicants’ request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The inventorship of record herein remains that set forth in the international application, that is, David BURTON and Scott PHILHOWER. The declaration filed 23 July 2007, which includes a third inventor, is therefore defective for failure to properly identify the inventors of record herein.

In addition, as noted above, the filed declaration document also appears to be an unacceptable compilation of multiple declarations.


If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled “Renewed Request Under 37 CFR 1.497(d)” and must include the materials required to satisfy items (A) and (C) of a grantable request, as discussed above, that is, the required statement from the inventor to be added, and the written consent of the assignee(s) to the proposed change, in the form required by 37 CFR 3.73(b). Applicants must also provide copies of the complete declarations executed by each of the inventors listed on the declaration (in order to resolve the compilation issue).

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

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<sup>1</sup> The compilation is evident in that the four-page declaration document consists of two different versions of what appears to be the second page of a three page document, each signed by one of the two inventors named on such page.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in dark ink, appearing to read 'R. M. Ross', with a stylized, cursive script.

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